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MPH TECHNOLOGIES OY

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
OAKLAND COURTHOUSE

MPH TECHNOLOGIES OY,

Plaintiff,

v.

APPLE INC.,

Defendant.

CASE NO. 4:18-cv-05935-PJH

Judge Phyllis J. Hamilton

**SEVENTH JOINT NOTICE OF STATUS
OF PETITIONS FOR *INTER PARTES*
REVIEW**

1 Pursuant to the Court’s April 26, 2019, Order Staying Case Pending IPR and Vacating
2 Hearing (Dkt. No. 49), this case was stayed pending final resolution of eight *inter partes* reviews
3 (IPRs) filed by Apple. The parties jointly submit this notice to update the Court on the status of
4 the IPRs.

5 Since the submission of the parties’ Sixth Joint Notice of Status of Petitions for *Inter Partes*
6 Review (Dkt. No. 61) on June 9, 2022, the Federal Circuit has issued an opinion and judgment in
7 Consolidated Appeal Nos. 2021-1355 and 2021-1356. In its opinion, the Federal Circuit affirmed
8 the Patent Trial and Appeal Board’s (“PTAB”) final written decision holding that Apple failed to
9 show that claims 6-8 of U.S. Patent No. 7,937,581 (the “’581 patent”) are obvious. The Federal
10 Circuit vacated the PTAB’s patentability determinations for claim 4 of the ’581 patent and
11 claims 1-6 of the 7,620,810 (the “’810 patent”) based on its finding that the PTAB erroneously
12 construed the claim term “encrypted” for both patents and remanded for further consideration.
13 Following the Federal Circuit’s opinion, MPH disclaimed claim 4 of the ’581 patent and claims 1-3
14 of the ’810 patent.

15 Pursuant to an agreement of the parties reached in connection with MPH’s forthcoming
16 motion to lift the stay to resume the litigation before this Court, the parties are concurrently filing
17 a joint stipulation as to the following:

- 18 • MPH dismisses all claims of alleged infringement of the ’810 patent in the above-captioned
19 action (including without limitation Count VI of MPH’s Complaint, ECF No. 1) with
20 prejudice and agrees (on behalf of itself and any future owners of, exclusive licensees to,
21 or successors-in-interest to any rights in the ’810 patent) not to assert the ’810 patent
22 against Apple, or against any other entity (including without limitation customers,
23 distributors, manufacturers, and suppliers) for any allegedly infringing activities with
24 respect to any Apple product or service, in the future (“covenant not to assert”); and
- 25 • Apple dismisses all counterclaims regarding the ’810 patent (including without limitation
26 Counts XI and XII of Apple’s Counterclaims, ECF No. 38) without prejudice. Apple
27 agrees not to assert any counterclaims regarding the ’810 patent in this action or otherwise
28 file any new challenge to the validity of the claims of the ’810 patent in any forum except

1 in the event that Apple believes in good faith there has been a breach of the covenant not
2 to assert.

- 3 • MPH's dismissal of all claims of alleged infringement of the '810 patent has no effect on
4 or consequence as to MPH's remaining patent infringement claims asserting U.S. Patent
5 No. 7,937,581, U.S. Patent No. 8,346,949, U.S. Patent No. 9,762,397, U.S. Patent No.
6 8,037,302, U.S. Patent No. 9,712,494, U.S. Patent No. 9,712,502, and U.S. Patent No.
7 9,838,362. Nor does its dismissal constitute any admission with respect to the merit or lack
8 of merit of MPH's patent infringement claims in this litigation.

9 MPH intends to move to lift the stay to resume the litigation before this Court. Apple does
10 not oppose MPH's motion.

1 Dated: January 9, 2023

Respectfully submitted,

2 /s/ Ashley E. LaValley

3 Attorneys for Plaintiff
4 MPH TECHNOLOGIES OY

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11 Dated: January 9, 2023

Respectfully submitted,

12 /s/ Bitra Rahebi (with permission)

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ATTESTATION CLAUSE

I, Ashley E. LaValley, am the ECF user whose identification and password are being used in this filing. In compliance with Civil Local Rule 5-1(i)(3), I hereby attest that Bitra Rahebi of Morrison & Foerster LLP has concurred in the filing of this document.

Dated: January 9, 2023

/s/ Ashley E. LaValley